

REMARKS

Applicant gratefully acknowledges the allowance of claims 101-104.

Applicants respectfully traverse the rejection of claims 105-119 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. None of pending claims 105-119 recite any matter not already supported in the application as originally filed. Therefore, pending claims 105-119 comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

In rejecting claims 105-119, the office action states: "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection." Applicants note, as an initial matter, that the office action's asserted new matter rejection is improper under MPEP § 2163.01:

"A written description requirement issue generally involves the question of whether the subject matter of a claim is supported by the disclosure of an application as filed. If the examiner concludes that the claimed subject matter is not supported in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph or denial of the benefit of the filing date of a previously filed application. The claim should not be rejected or objected to on the ground of new matter. As framed by the court in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the abstract, specification or drawings attempting to add new disclosure to that originally presented."

Applicants further note that MPEP § 2163(III)(A) specifically states that in order to establish a prima facie case of lack of written description support under 35 U.S.C. § 112, the office action must provide "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed." The office action states that

some claimed elements were disclosed only in relation to one embodiment (see page 3), however, the office action provides no reason for why a person skilled in the art would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure, and therefore the rejection under 35 U.S.C. § 112, first paragraph, is also improper.

Applicants contend that the rejected claims are fully supported by the specification. Pending claims 105 and 111 recite a method of playing a wagering game comprising providing an electronic database of a plurality of questions for presentation to the player where the questions are separated into a plurality of question groups wherein the question groups offer different potential values to the player and where the question groups with more difficult questions offering higher potential values to the player. As acknowledged by the office action, this step is disclosed in the specification (specifically on pages 10-11).

Pending claim 105 further recites providing an electronic database of a plurality of answer groups each comprising a plurality of answers associated with one of said questions for presentation to the player, each answer group including at least one desirable answer and at least one undesirable answer. Claim 111 further recites providing an electronic database of a plurality of answer groups each comprising a plurality of answers associated with one of said questions for presentation to the player, each answer group including at least one desirable answer and a plurality of undesirable answers. As acknowledged by the office action, the element of an answer group having both desirable and undesirable answers is disclosed in the specification relating to the "FAMILY FEUD" embodiment (specifically, on page 7).

The office action asserts that claims 105 and 111 "recite a particular combination of elements that cross disclosed embodiments and accordingly are new matter," without addressing why persons skilled in the art would not have recognized that the inventor was in

possession of this combination in view of the disclosure of the application. Applicants emphasize that there is no requirement that a claim encompass only a single embodiment. In fact, MPEP § 2613 (II)(A)(3)(a) recognizes such combinations as genus claims, stating that, "a claim which is limited to a single disclosed embodiment or species is analyzed as a claim drawn to a single embodiment or species, whereas a claim which encompasses two or more embodiments or species within the scope of the claim is analyzed as a claim drawn to a genus."

The office action states that answer groups having both desirable and undesirable answers are disclosed only in relation to the FAMILY FEUD embodiment. There is no language in the specification limiting the use of answer groups having desirable and undesirable answers to any particular embodiment. In addition, Applicants note that answer groups having both desirable and undesirable answers are disclosed in the FAMILY FEUD embodiment, on page 7, as well as the JEOPARDY embodiment, at least on page 10, second paragraph:

"The instant invention may be adapted for playing a Jeopardy variant as follows. For each question, there is a single correct, 'desirable' answer; and one or more predetermined incorrect 'undesirable' answers may be provided. Both the desirable and undesirable answers may be placed in a database."

In support of the cross combination of game elements, page 11 of the specification shows that the disclosed elements described in the FAMILY FEUD and JEOPARDY embodiments could be applied to other games:

"It should be appreciated that the 'Trivial Pursuit' and the 'Who Wants to Be A Millionaire' games may be presented as variants similar to that described with reference to the Jeopardy game."

In further support, the specification, last paragraph, states:

"Although specific embodiments of the present invention have been disclosed and illustrated, herein, it should be recognized that modifications and variations may readily occur to those skilled in the art and that such modifications and variations may be made without departing from the spirit

and scope of our invention. Consequently, our invention as claimed below may be practiced otherwise than as specifically described above."

The applicant freely admits that "claims may be no broader than the supporting disclosure, and therefore ... a narrow disclosure will limit claim breadth." Gentry Gallery, 134 F.3d at 1480. For example, a narrow disclosure will limit claim breadth in "the situation where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an 'essential element of [the inventor's] invention.'" Johnson Worldwide Assocs. v. Zebco Corp., 175 F.3d 985, 993 (Fed. Cir. 1999) (quoting Gentry Gallery, 134 F.3d at 1480 [a claim was invalid for failure to meet the written description requirement on this basis]). The pending specification does not describe THE invention of THE embodiment but a variety of different embodiments. Accordingly, the pending claims should not be limited.

The office action fails to present a prima facie case of lack of written description support under 35 U.S.C. § 112, because the office action does not provide a reason why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. The noted claim elements are fully supported in the application disclosure and therefore, the rejection of claims 105-119 for lack of written description support is traversed.

CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons, Applicants respectfully request reconsideration and allowance of rejected claims 105-119.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call their attorney at the number listed below.

Respectfully submitted,

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